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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,555	09/05/2003	Laurence R. O'Halloran	57063.000003	6416

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/655,555	<b>Applicant(s)</b> O'HALLORAN, LAURENCE R.	
	<b>Examiner</b> Michael Peffley	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/11/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 10 both lack proper antecedent basis for "the insulated tubing assembly". There are multiple occurrences of this phrase in the claims. Claim 1 and claim 10 each recite "a tubing assembly" in line 3, and therefore fail to provide specific support for "the insulated tubing assembly" recited thereafter.

Claim 19 is unclear. It states that the cautery surface is substantially co-planar. It is not clear with what the surface is co-planar.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-10, 14-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wojciechowicz (5,730,742).

As best depicted in Figures 7a and 7b, Wojciechowicz discloses a suction cautery dissector including a handle assembly (14 – shown in Figures 1a-1c), a tubing assembly (18) having a suction channel (i.e. central lumen) formed therein. The tubing assembly includes a tip assembly comprising a cautery surface (104) having a beveled leading edge for dissecting tissue, the cautery surface having an opening in

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communication with the central suction lumen. The cautery surface is connected to an electrical source and includes an insulating layer (18) covering the suction channel and terminating a predetermined distance ( $D_0$ ) from the tip of the cautery surface. The beveled edge is about 45 degrees (see Figure 7B) and a wire is connected to the conductive suction channel within the handle assembly (see Figure 1C). The handle also includes a suction port (16) to control suction of air through the opening in the cautery surface. It is noted that the surface of the cautery leading edge is ovoid in shape (see Figure 7A).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison, Jr. (3,828,780) in view of the teaching of Wojciechowicz ('742).

Morrison, Jr. Discloses a cautery suction device including a handle assembly (10), a tubing assembly (32) having a channel therein and a tip assembly (30) at the end of the tubing assembly. The tip assembly includes a cautery tip with an opening in communication with the suction channel. The tubing assembly includes an insulated covering (32) that terminates a predetermined distance from the end of the cautery tip (see Figure 1). Morrison, Jr. also disclose that the tubing assembly may include a bend (Figure 1), and the handle assembly includes an electrical wire (26) that is connected to

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a conductive tube within the handle assembly to provide cautery energy to the cautery tip. A suction control (22) is provided on the handle assembly to control the suction through the central channel. The only feature not expressly taught by Morrison, Jr is a cautery tip that has been sharpened to facilitate tissue dissection.

As addressed previously, Wojciechowicz disclose substantially an identical suction cautery device. In particular, Wojciechowicz teach that the cautery tip may be provided with either a flattened tip (Figures 2-4), or with a beveled, sharpened tip to facilitate tissue dissection (Figures 7A and 7B). To have provided the Morrison, Jr. tip with a sharpened edge to facilitate tissue dissection would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Wojciechowicz.

With regard to claims 4, 5, 12 and 13 the examiner maintains that the particular angle and location of the bend of the Morrison, Jr. device would be an obvious consideration for one of ordinary skill in the art and dependent on the particular procedure.

Similarly, the particular shape of the cautery surface (i.e. semi-cylindrical as set forth in claim 18) is deemed to be an obvious design consideration. The cited prior art shows a variety of shapes for similar cautery surfaces. See, for example, Helenowski (5,084,045).

### ***Conclusion***

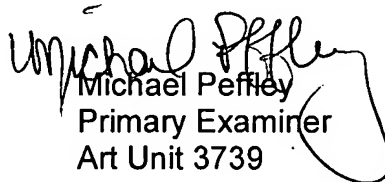
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Considine et al (5,441,503) and Reimels et al (5,925,045) disclose other suction cautery devices.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
September 16, 2005